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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,655

08/25/2003

Geno Munari

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08/16/2005

QUIRK & TRATOS

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EXAMINER

NEGRON, ISMAEL

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,655

Applicant(s)

MUNARI, GENO

Examiner

Ismael Negron

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendments filed on May 23 and June 7, of 2005 has been entered. Claims 1, 5, 6, 9, 12, 13 and 15 have been amended. No claim has been cancelled or added. Claims 1-18 are still pending in this application, with claims 1, 9 and 15 being independent.

Abstract

2. The abstract of the disclosure is objected to because it refers to the purported merits or speculative applications of the invention and compare the invention with the prior art. Correction is required. See MPEP § 608.01(b).

The Examiner suggests deleting the first sentence of the Abstract.

In the previous Office Action the Examiner incorrectly suggested deleting the first and last two sentences of the abstract, instead of deleting the first two and the last sentence of such abstract.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 6, 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 5 is indefinite as the recitation "the resilient strap is elastic" implies that the claimed invention positively features a resilient strap, while previous Claims 1 (from which the rejected claims depends) defined the claimed invention as having a resilient strap or two or more flexible members. It is not clear if the claimed invention necessarily includes a resilient strap, or if it is merely one of two different options. Claim 12 is rejected for similar reasons.

5. Claim 6 is indefinite as the recitation "the flexible members are metallic" implies that the claimed invention positively features a plurality of flexible members, while previous Claims 1 (from which the rejected claims depends) defined the claimed invention as having a resilient strap or two or more flexible members. It is not clear if the claimed invention necessarily includes a plurality of flexible members, or if it is merely one of two different options. Claim 13 is rejected for similar reasons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4, 9, 10 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by LAMBERT (U.S. Pat. 5,124,892).
7. LAMBERT discloses an illumination device having:
 - **a housing (as recited in claims 1 and 9),** Figure 1, reference number 22;
 - **a light source (as recited in claims 1 and 9),** Figure 3, reference number 24;
 - **the light source being located within the housing (as recited in claims 1 and 9),** as seen in Figure 3 ;
 - **a power source (as recited in claims 1 and 9),** Figure 2, reference number 26;
 - **the power source being located within the housing (as recited in claims 1 and 9),** as seen in Figure 2;
 - **means for intermittently activating the light source (as recited in claims 1 and 9),** Figure 2, reference numbers 32 and 34;

- **a resilient fastener (as recited in claims 1 and 9), Figure 1, reference number 28;**
- **the fastener being for removably attaching the housing to a human finger or thumb (as recited in claims 1 and 9), column 3, lines 1-4;**
- **the light source being a light emitting diode (as recited in claims 2 and 10), column 2, lines 27 and 28;**
- **the means for intermittently activating the light source including applying pressure to a button exposed near a first end of the housing (as recited in Claim 4), column 3, lines 34-40;**
- **the button causing the power source to activate the light source as long as the pressure is applied to the button (as recited in Claim 4), column 2, lines 51-54;**
- **a button (as recited in Claim 9), Figure 2, reference numbers 32 and 34;**
- **the button being located near one end of the housing (as recited in Claim 9), as seen in Figure 2;**
- **the button closing an open electrical circuit to activate said light source (as recited in Claim 9), column 3, lines 34-40;**

- **the button closing the circuit when pressed (as recited in Claim 9), column 3, lines 34-40.**

8. The limitations recited by method claims 15-17 were considered as inherently disclosed by the structural elements of the patented apparatus of LAMBERT, as detailed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 5-8, 11-14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over LAMBERT (U.S. Pat. 5,124,892) in view of RADLEY (U.S. Pat. 914,975).

10. LAMBERT discloses an illumination device having:

- **a housing (as recited in claims 1 and 9), Figure 1,**
reference number 22;
- **a light source (as recited in claims 1 and 9), Figure 3,**
reference number 24;

- **the light source being located within the housing (as recited in claims 1 and 9), as seen in Figure 3 ;**
- **a power source (as recited in claims 1 and 9), Figure 2, reference number 26;**
- **the power source being located within the housing (as recited in claims 1 and 9), as seen in Figure 2;**
- **means for intermittently activating the light source (as recited in claims 1 and 9), Figure 2, reference numbers 32 and 34;**
- **a resilient fastener (as recited in claims 1 and 9), Figure 1, reference number 28;**
- **the fastener being for removably attaching the housing to a human finger or thumb (as recited in claims 1 and 9), column 3, lines 1-4;**
- **a button (as recited in Claim 9), Figure 2, reference numbers 32 and 34;**
- **the button being located near one end of the housing (as recited in Claim 9), as seen in Figure 2;**
- **the button closing an open electrical circuit to activate said light source (as recited in Claim 9), column 3, lines 34-40;**

- **the button closing the circuit when pressed (as recited in Claim 9), column 3, lines 34-40.**

11. LAMBERT discloses all the limitations of the claims, except:

- the battery being a lithium battery (as recited in claims 3 and 11);
- the resilient strap being an elastic band (as recited in claims 5 and 12);
- the flexible members being metallic (as recited in claims 6 and 13);
- a flesh colored sheath for covering the housing (as recited in claims 7 and 14); and
- the housing being transparent (as recited in Claim 8).

12. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a lithium battery (as recited in claims 3 and 11) instead of the batteries disclosed by LAMBERT, since the Examiner takes Official Notice that the use of lithium batteries is old and well known in the illumination art. One would have been motivated since lithium batteries are recognized to have many desirable advantages, including reduced size, high efficiency, and high power production, over other batteries.

13. Regarding the resilient strap or plurality of flexible members being an elastic band (as recited in claims 5 and 12) or metallic (as recited in claims 6 and 13), it would

have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use elastic band or metallic straps, since such resilient straps are art-recognized equivalents. One would have been motivated by the specific requirements of a particular application.

14. Regarding the flesh colored sheath for covering the housing (as recited in claims 7 and 14) or the housing being transparent (as recited in Claim 8), it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a flesh-colored sheath or a transparent housing, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

15. The limitations recited by method Claim 18 were considered as inherently disclosed, or suggested, by the structural elements of the patented apparatus of LAMBERT, as detailed above.

Response to Arguments

16. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.


20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.


Inr

August 11, 2005


THOMAS M. SEMBER
PRIMARY EXAMINER